

II. Rejections under 35 U.S.C. § 102:

Claims 1-14 have been rejected as allegedly anticipated by U.S. Patent Nos. 5,733,566 ("Lewis") or 5,792,469 ("Tipton"). The claims have been amended to overcome the rejections.

Applicants respectfully submit that neither Lewis nor Tipton discloses the present invention as claimed in independent claims 1 and 13, as amended. Yewey describes compositions that, after being inserted, "solidify or cure . . . to form a solid or gelatinous matrix," (Col. 5, lines 7-9). Similarly, Lewis forms microparticles that serve as a matrix from which the active agent is dispersed. Thus, neither discloses a film encapsulated liquid implant as claimed in independent claims 1 and 13, as amended.

Accordingly, independent claims 1 and 13, as amended, are not anticipated by Lewis or Tipton. Claims 2-12 and 14, depending from claims 1 and 13 respectively, are also not anticipated by Lewis or Tipton for that reason as well as for the additional elements they recite. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102.

IV. Rejections Under 35 U.S.C. § 103:

Claims 1-14 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent Nos. 5,278,202 ("Dunn"), 5,780,044 ("Yewey"), and Lewis. Applicants respectfully submit that none of the references make obvious the present invention as claimed in claim 1 or 13, as amended.

As described above, none of the references discloses a film encapsulated liquid implant as claimed in independent claims 1 and 13, as amended. Furthermore, each reference teaches away from the present invention. Dunn states at column 7, line 29, that "the solid implant [is] formed within the injectable polymer solution." Thus, Dunn teaches away from forming an implant that is a film encapsulating a liquid. Yewey and Lewis each describes solidifying compositions to form a matrix of solid microparticles from which the active ingredient is dispersed. Thus, they teach that the active ingredients should be incased within a multitude of solid microparticles that, in combination, form a matrix – opposite in scale, number, and form from the film encapsulated liquid implant as claimed in independent claims 1 and 13, as amended. The scale of the Yewey and Lewis microparticles are much smaller, the number much more numerous, and the solid matrix form is unlike a film encapsulated liquid. One of ordinary skill reading Dunn, Yewey, or

Lewis is given no disclosure, teaching, or suggestion of the composition of the present invention which forms a film encapsulated liquid implant.

The Examiner states that "one skilled in the art would have been able to select solvents that stay inside matrix for a longer period of time forming a film encapsulating liquid." However, Applicants respectfully suggest that the Examiner is impermissibly using an obvious to try standard using the present disclosure as a template. None of the references provide motivation, absent the present disclosure, to form a film encapsulated liquid implant as claimed in independent claims 1 and 13, as presently amended.

Therefore, independent claims 1 and 13 are not obvious in light of Dunn, Yewey, and Lewis. Claims 2-12, and 14 depending from claims 1 and 13 respectively are also not obvious for that reason as well as for the additional elements they contain. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

#### Conclusion

Applicants respectfully submit that the application is in condition for allowance because all the rejections have been overcome and request a Notice to that effect.

If a telephonic discussion would be helpful to further the prosecution, Applicants' attorney can be reached at the telephone number below. Correspondence should continue to be directed to the address below. Any deficiencies in fees should be charged to Deposit Account 13-2755.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date appearing below.

MERCK & CO., INC.  
By Shu M. Lee Date 8/23/2000

Date: August 23, 2000

Respectfully submitted,

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